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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,652

02/25/2005

Heinz Focke

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09/05/2007

SUGHRUE MION, PLLC

2100 PENNSYLVANIA AVENUE, N.W.

SUITE 800

WASHINGTON, DC 20037

EXAMINER

BUI, LUAN KIM

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

09/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/525,652

Applicant(s)

FOCKE ET AL.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/25/05 &amp; 11/15/06</u> | 6) <input type="checkbox"/> Other: ____  |

*Specification*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

2. The specification is objected to under 37 CFR 1.71, as the specification, as originally filed, does not provide support for the new matter as now claimed. The specification as filed does not provide support for the collar having a collar front wall with a collar opening (claim 10) and the lower part of the collar front wall having a protrusion projects partially into the region of the opening (claim 13). The specification as filed fails to provide support for the combination of claims 8-10 and 13. If claim 13 is directed to a different embodiment then it will be restricted in the next Office Action.

3. Claim 13 is rejected under 35 USC 112, first paragraph, for the reasons set forth in the objection to the specification.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase “-printing or embossing-” is alternative and indefinite because it has no clear meaning and the dash lines should be deleted. The phrases “the inner wrapper” in claim 9, “the collar” in claims 10 and 17, and “at least the marking” in claim 15 lack proper antecedent basis. Claims 10 and 17 are vague, confusion and indefinite because it is not clear what is the relationship between the pack and a collar front wall on line 2.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over The International Publication Number WO 02/28745 to Conti et al (hereinafter Conti'745) in view of Parker (6,505,735) and Focke et al. (6,138,823; hereinafter Focke'823). To the extent that the Examiner can determine the scope of the claims, Conti'745 discloses a cigarette pack (1) having at least two blanks comprising an inner blank (page 5, lines 9-16) which surrounds a cigarette

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group preferably on all sides and an outer pack blank (2, 5) made of paper, thin cardboard or similar material. The outer pack blank having at least one opening (20) in the region of at least one pack wall. The pack further comprises a coupon (19) having written and pictorial matter addressed to the consumer and the coupon interposed between a collar (15) and the inner blank (page 5, lines 25-30) and it appears that the coupon is attached to the inner blank otherwise the coupon would drop to the bottom wall (7) of the pack during manufacture and/or handling which is considered equivalent to the inner blank comprises at least one marking which in the finished pack lies at least partially in the region of the opening and which is visible through the opening as claimed.

To the extent that Conti'745 fails to show the coupon being attached to the inner blank which is considered to the inner blank as claimed, Parker shows a cigarette pack (1, 2) comprising an inner blank (3) having an opening and a label (7) attached by an adhesive to the inner blank to cover the opening. Focke'823 teaches a cigarette pack (10, 11) having a coupon (50, 51) composed of words and/or pictures printed thereon and the coupon is printed on at least a collar front wall. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Parker and Focke'823 to modify the pack of Conti'745 so the coupon is attached to the inner blank as taught by Parker or the coupon is printed directly on the inner blank as taught by Focke'823 to reduce the step of manufacture and also because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 10, Conti'745 discloses the collar (15) comprises at least one opening (23) in a collar front wall.

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As to claims 11-12, Focke'823 teaches the recesses (46, 47) produced by stamping or the opening in the inner blank of Parker produced by stamping.

As to claim 16, Focke'823 teaches a cover layer (58) in the region of the recess/opening.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lkb  
September 2, 2007

/Luan K. Bui/  
Primary Examiner  
Art Unit 3728